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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,358

Applicant(s)

DODD, RUSSELL CHARLES

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicant's amendment filed September 22, 2004 is acknowledged. Accordingly, claims 1-9 and 14 remain pending.
2. There is some confusion by Applicant regarding the USPTO serial number in this case. The Examiner notes that according to the image file wrapper ("IFW") system, the original serial number is as noted at the top of this Office Action. Applicant's First Appeal Brief filed May 14, 2004 noted the serial number incorrectly as 09/653,012. While Applicant's latest response on page 1 properly indicates the serial number as 09/931,358, page 2 of the same response improperly indicates the serial number as 09/985,027. Moreover, page 2 in Applicant's response filed September 11, 2003 (the latest response in which a set of claims was filed) indicates that the serial number is 09/985,027. In order to rectify this issue, Applicant is respectfully requested to submit a copy of the claims (in his next appropriate response) which includes the proper serial number on the claim sheets. From now on, failure by Applicant to properly indicated the appropriate serial number for this application in all pages submitted will result in Applicant's response being held non-responsive.
3. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" refers to examiner(s) generally.

Art Unit: 3627

4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Claim Rejections - 35 USC §112 2nd Paragraph

5. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9 and 14 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the recitation of “calculated with respect to at least one of said customers” is indefinite. One of ordinary skill in the art would not be able to ascertain how the consumer sales projection information is calculated. Appropriate correction is required.

Claim Rejections - 35 USC §102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3627

8. Claims 1-9 and 14, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Peterson et. al. (U.S. 6,324,522 B2) ("Peterson '522"). Peterson '522 discloses providing an interface the (the web based interface); receiving customer ID information (the purchaser must identify themselves); receiving an indication of interest (viewing or clicking an item of interest); accessing customer information (the log in); proving product information (the various information provided).

Claim Rejections - 35 USC §103

9. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roberts et. al. (U.S. 6,101,486) ("Roberts") in view of Brockman et. al. (U.S. 5,826,240) ("Brockman"). Roberts discloses as previously discussed. See the Final Office Action mailed December 16, 2003, Paper No. 13 ("Second Final Action"), Paragraph No. 3.

11. Claims 1-9 and 14 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson '522.¹ It is the Examiner's principle position that the claims are anticipated because the sales projection information that is customized on the basis of planned promotional activities is inherent (i.e. the item is on sale).

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Peterson '522 to include the sales projection information that is customized on the basis of planned promotional activities.

Moreover, if not inherent in Peterson '522, the missing elements in Peterson '522 are nonfunctional descriptive material and are not functionally involved in the steps claimed (*i.e.* the steps of "providing . . . product information" is in no way dependent upon the content of the of what is provided). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Peterson '522 with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). See also MPEP §2106 IV B.

12. Moreover, as a starting point and in reference to elementary electronic commerce systems, it is the Examiner's factual determination that web based electronic commerce systems are old and very well known in the art. Evidence to support this finding includes *e.g.* Chen et. al. (U.S. 5,590,197 A) ("Chen") and Wong (U.S. 6,115,690 A). Chen and Wong exemplify basic features that are well within the knowledge of one of ordinary skill in this art. See also Danneels et. al. (U.S. 6,272,472) for an exemplary web based catalog-like electronic commerce system.

13. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual

Art Unit: 3627

findings. First and as noted in the previous Office Action,² the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,⁵ Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁶ to be his own lexicographer.⁷ Accordingly and for due process purposes, the

² See the Examiner's previous Office Action mailed June 22, 2004, Paragraph No. 12.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See again the Examiner's previous Office Action, , Paragraph No. 12.

⁶ *Id.*

⁷ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner.

Art Unit: 3627

Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

Response to Arguments

14. Applicant’s arguments filed September 22, 2004 have been fully considered but they are not persuasive.

Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed December 19, 2004).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

35 USC §112 2nd Paragraph

15. Applicant argues that “[t]he Office Action merely states a conclusion of indefiniteness without any analysis or support for this conclusion.”¹⁰ Additionally, Applicant argues that the “indefiniteness rejection requires the examiner to take into account the content of the particular application disclosure”¹¹ The Examiner respectfully disagrees.

16. It is the Examiner’s position that during ex parte examination, if a claim is indefinite on its face, then a rejection under 35 USC §112 2nd paragraph properly lies. See MPEP §2111.01. In this case, the Examiner finds that claim 1 is indefinite on its face.

17. Regarding Applicant’s discussion of the Wands factors, Applicant’s argument is not persuasive. The Examiner agrees that determining whether one skilled in the art can practice the claimed invention, the Wands factors must be considered. However this analysis is appropriate for 35 USC §112 1st paragraph, not 35 USC §112 2nd paragraph. As the record shows, there are no 35 USC §112 1st paragraph rejections in this Office Action.

18. “While not an absolute rule, all claim terms are presumed to have meaning in a claim.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1119, 72 USPQ2d 1001, 1007 (Fed. Cir. 2004). Claim 1 recites “at least some product information provided [to the at least one of the customers] comprises consumer sales projection information [and this sales projection information is] calculated with respect to said at least one of said customers.” The Examiner finds that the sending demand information (for any given product) to the customer meets this limitation. It is the Examiner’s factual determination that demand information is

¹⁰ Applicant’s Remarks, filed September 22, 2004, Page 2, ¶4.

¹¹ Id.

Art Unit: 3627

synonymous for inventory projection information and is—for any given product—virtually always calculated with respect to a customer. Evidence to support this includes *e.g.* Shipman (U.S. 5,819,232) (“Demand forecasting can be done by knowledgeable people, usually sales representatives, making a projection of future demand based on experience, *customer information*, and general economic conditions. [Emphasis added.]”); Glenditsch et. al. (U.S. 6,393,332) (noting that “a projection of demand on manufacturing resources over time [is] based on one or several of *actual customer orders*, future forecasts of customer orders, *historical data of past customer shipments*, current amounts of finished goods inventory, and predefined parameters related to the manufacturing resources. [Emphasis added.]”); and Lee et. al. (U.S. 5,712,985). In other words, demand information is a function of customer factors. Demand can not be adequately calculated without some form of customer input. For additional information on how demand is calculated as a function of customers, See Hirschey et. al.’s Managerial Economics, 8th Ed. (“Managerial Economics”).

19. Additionally, the product information provided is always customized on the basis of the identifying customer information accessed (*e.g.* the customer selling watches will get ‘custom’ information related to watches; the customer selling radios will get “custom” information related to radios; the customer selling radios will not get information related to watches). In other words with the identifying criteria being the customer information, the information the customer receives will be based upon their request and in that sense, customized to their business or their request. And if the demand is always at least (partly) a function of consumers, then demand or “sales projection information” is always calculated “with respect to at least one of said customers.” Therefore, the recitation of “calculated with respect to at least one of said

Art Unit: 3627

customers” appears duplicative and therefore unclear since this will always occur. Its as if Applicants are reciting ‘the square having four corners.’ Therefore claim 1, on its face, it is unclear since it is not known what is meant by “calculated with respect to at least one of said customers.”

20. Regarding Peterson ‘522, Applicant argues that “there is no indication that the information about the product itself is customized on the basis of vendor information (or customer information).”¹² Again, the Examiner respectfully disagrees.

21. First, the vendor information is clearly a vendor number (or vendor name) or other indicator unique to the vendor. When e.g. vendor #567 receives information on a product that it requested from a manufacturer, then the vendor has received the custom information. Unless requested, the other vendors do not ordinarily receive this information. For these reasons, Applicant’s argument is not persuasive.

22. Regarding Applicant’s illustration on page 4, the Examiner understands Applicant’s intent. However concepts and constructs present in the figure on page 4 are not entirely reflected in claim 1. In other words and as Judge Clevenger has so eloquently summarized these types of arguments, “The invention disclosed in [Applicant’s] written description may be outstanding in its field, but the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

23. Finally, the Examiner respectfully disagrees with Applicant’s diagram on page 5 of his Remarks. For these reasons, Applicant’s arguments are not persuasive.

¹² Applicant’s Remarks, Page 3, ¶12.

Lexicography

24. Regarding lexicography and as noted above, Applicant has failed to point to the terms and their respective definitions with the required clarity, deliberateness, and precision. During ex parte examination, simply stating ‘I am my own lexicographer’ will not successfully invoke lexicography. Without expressly pointing to both a term *and* its definition, the broadest reasonable interpretation remains. “To balance the importance of public notice and the right of patentees to seek broad patent coverage, we have thus consistently rejected prosecution statements too vague or ambiguous to qualify as a disavowal of claim scope.” *Omega Engineering Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-26, 67 USPQ2d 1321, 1328-29 (Fed. Cir. 2003)(citations and footnote omitted). See also *e.g. Abbott Labs. v. Baxter Pharm. Prods.*, 67 USPQ2d 1191, 1194 (Fed. Cir. 2003)(“Because the patentee did not deviate from the accustomed meaning of the disputed claim term, the term ‘effective amount’ is construed in view of its ordinary and customary meaning.”).

25. As noted above, the Examiner has carefully reviewed specification. It states *e.g.* “For purposes of the present specification, the term customer will refer to any purchaser of goods where such purchaser intends to re-sell such goods to another entity, person, or groups of persons in the course of such customer’s business.” The Examiner accepts this statement. For purposes of the *specification*, the term ‘customer’ will be understood as noted above. For purposes of the *claims* however, the term ‘customer’ will be given its broadest reasonable interpretation. The specification is equally unavailing to the terms “consumer” and “goods” as well.

26. The Examiner agrees that if Applicant can show with clear and convincing evidence that he intended to be his own lexicographer for any claim term, the Examiner has no choice but to examine the claims with that meaning. However Applicant has not yet met his burden, especially with respect to customer, consumer, and goods.

27. To be clear, the Examiner has never *required* Applicant to be his own lexicographer. It is Applicant's burden to define their invention, not the Examiner's.¹³ In complying this burden, Applicant is reminded that it is Applicant—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore *Applicant* who must have decided whether or not to be his own lexicographer.¹⁴ Along the same line of reasoning, whether or not Applicant chose this or that particular method of claim construction (*e.g.* lexicography or perhaps 35 U.S.C. §112 6th paragraph) is also completely within Applicant's discretion.

28. Second, Applicant is reminded that claim terminology is fixed upon filing. See *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) ("The meaning of a patent term, however, is not subject to revision The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]"); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) ("Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the

¹³ *In re Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2nd paragraph, "It is the applicants' burden to precisely define the invention, not the PTO's.").

¹⁴ See *e.g. Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (noting that "It is the inventor applying for a patent who is permitted to be his own lexicographer," not the examiner).

Art Unit: 3627

art as of the application date. [Emphasis added.]”)(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)(“We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”); *Kopykake Enterprises Inc. v. Lucks Co.*, 264 F3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”); and *In re Bass*, 314 F.3d 575, 577-78, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

29. So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed. While the meaning may be ‘uncovered,’ ‘corralled,’ or ascertained during either ex parte examination or inter partes litigation,¹⁵ the meaning of claim terms nevertheless remains fixed. It is self evident that failure to construe a claim during either ex parte examination or inter partes litigation does not change the fact that the meaning of claim terms is fixed upon filing. And terms or definitions that actually *change* claim meaning by their inclusion *after* the filing date of the application are improper under either

¹⁵ See e.g. *Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (“Where, as here, the patentee has clearly defined a claim term, that definition usually is dispositive; it is the single best guide to the meaning of a disputed term.”).

Art Unit: 3627

35 U.S.C. §112 1st paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter.

30. Third, the Examiner recognizes that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.¹⁶ However this does not relieve the drafter of deciding whether or not to be their own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated *prior to* filing the patent application. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography and quoting *Lear*, “the place to do so is in the specification of the inventor’s application, and the time to do so is *prior to* that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. [Emphasis added.]” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

31. Applicant is also reminded that the USPTO has the authority to set reasonable deadlines or requirements. “The PTO is the administrative agency that is ‘responsible for the granting and issuing of patents’ 35 U.S.C. §2 (2000). Like other administrative agencies, the PTO may impose reasonable deadlines and requirements on parties that appear before it. The PTO has inherent authority to govern procedure before the PTO, and that authority allows it to set reasonable deadlines and requirements for the prosecution of applications.” *In re Bogese*, 303 F.3d 1362, 1367-68, 64 USPQ2d 1448, 1452 (Fed. Cir. 2002) (footnote omitted). Although *Bogese* concerned latches, the concept of imposing reasonable deadlines and requirements upon

¹⁶ See e.g. *Johnson & Johnston Associates*, 285 F.3d at 1069, 62 USPQ2d at 1241, Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

Art Unit: 3627

applicants is pervasive at the USPTO and is generally accepted as a requirement of 37 C.F.R.

§1.111(b).¹⁷

32. Having established that claim terms are fixed upon filing, that Applicant is the master of his domain, and that the USPTO can set reasonable deadlines or requirements, the Examiner has simply required that if Applicant *knew of* or *intended* to be his own lexicographer, the Examiner respectfully requested that they point it out now. After the Examiner has brought this issue to Applicant's attention and after the Examiner has shown reliance on the *lack* of lexicographic definition(s) to interpret the claims, Applicant's continued failure to point out any *known* lexicographic definition(s) with the required clarity, deliberateness, and precision would be a violation of 37 C.F.R. §1.111(b), and perhaps, Applicant's duty of candor and good faith under 37 C.F.R. §1.56 which states in part: "(a) ... Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office" Issues of quasi-estoppel may also arise. See *e.g. In re Baker Hughes Inc.*, 215 F.3d 1297, 1301, 55 USPQ2d 1149, 1152 (Fed. Cir. 2000) (where the Federal Circuit first discussed quasi-estoppel during a patent prosecution case). In any event, one point however is clear, such comments by Applicant unmistakably confirm that Applicant has received express notice of the

¹⁷ For additional guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see *e.g.*: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in the next response by stating *why* the Examiner's position regarding restriction is *substantively* incorrect in order to preserve his or her right to petition; MPEP §2144.03 regarding Official Notice noting that traversal must be made in applicant's *next response*. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement *in the next reply* after the Office action in which the well known statement is made. [Emphasis added.]" Failure to seasonable challenge the official noticed statement *in the very next response* means the statement is interpreted as admitted prior art; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987)

Art Unit: 3627

Examiner's factual findings and legal conclusions regarding lexicography invocation and has been given the opportunity to defend against the noticed liabilities.

Conclusion

33. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

34. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

35. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

noting the examiners have no authority to waive 37 C.F.R. §1.111(b) and that an applicant is

Art Unit: 3627

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

37. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

required to point out *any* supposed errors in his next response.

Art Unit: 3627

38. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Hirschey et. al.'s Managerial Economics, 8th Ed. ("Managerial Economics") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Managerial Economics provides a basic foundation for understanding economic theory and analysis and its application to individuals, households, firms, nonprofit organizations, and government entities. Because the reference is an economic textbook directed towards students, because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the specification and prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Managerial Economics is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference. While the Examiner recognizes that Managerial Economics contains some complex economical concepts with sometimes difficult mathematical constructs, such concepts and constructs do not negate the Examiner's conclusion that such concepts, constructs, and other content within Managerial Economics is well within the knowledge of one of ordinary skill in this art.

39. Also in accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that the reference Introduction to Financial Accounting, Revised 3rd Ed. by Horngren et. al. ("Horngren") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that Horngren describes basic

Art Unit: 3627

financial accounting practices allowing the user to obtain a thorough grasp of the fundamentals of accounting. The reference is cited in its entirety. Moreover, because the reference is a introductory accounting textbook that presupposes no prior knowledge of accounting, because of the reference's basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Hornngren is primarily directed towards those of low skill in this art. Because Hornngren is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Hornngren.

40. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 2) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁸ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards

Art Unit: 3627

allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 19, 2004

¹⁸ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.